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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,344	06/26/2003	Ajay Mirtal	08212/0200294-US0	9288
23552	7590	01/21/2005		EXAMINER
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			DINH, MINH	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/609,344	MIRTAL ET AL.
	Examiner Minh Dinh	Art Unit 2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

## DETAILED ACTION

1. Claims 1-22 have been examined.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9, 14-15, 19-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Puhl et al (6,223,291).

Regarding claims 15, which is representative of claims 1 and 7-8, Puhl discloses a system comprising: a client computer configured to provide an electronic request for a license that includes information associated with an end user and an identifier associated with a software product (col. 6, lines 16-32); a Web server configured to receive the electronic request and to employ the information to authenticate the end-user (col. 6, lines 16-32); a Licensing Authority configured to digitally sign the license and notify the client computer where to obtain the license if the end-user is authentic, wherein the license enables access to the software product (col. 6, lines 16-32; col. 3, lines 1-10). Puhl's teaching of using a Web server to receive the request and authenticate the user for the Licensing Authority is not precluded from the claim language.

Regarding claims 2, 9 and 20, Puhl further discloses that the Licensing Authority operates substantially similar to a Certification Authority in a Public Key Infrastructure (col. 6, lines 16-32; col. 3, lines 1-10).

Regarding claim 3, Puhl further discloses receiving the electronic request from a web form (col. 3, lines 15-21).

Regarding claims 4 and 14, Puhl further discloses employing a financial institution to validate the information (col. 3, lines 21-23).

Regarding claim 5, Puhl further discloses that the information associated with the end user comprises credit card information (col. 3, lines 21-23).

Regarding claim 6, Puhl further discloses providing notification on how to access the license, wherein the notification comprises a web page (col. 6, lines 31-33).

Regarding claim 19, Puhl further discloses that the client computer is further configured to receive notification of how to obtain the license; install the license; and employ the license to enable access to the software product (col. 6, lines 32-35).

Regarding claim 22, the limitation "the license is substantially similar to a Public-Key Certificate in an Internet Public Key Infrastructure" (line 7) is interpreted as "the license is substantially similar in nature to a Public-Key Certificate in an Internet Public Key Infrastructure". Puhl discloses a system comprising: means for receiving an electronic request for a license that includes information associated with an end-user and an identifier associated with a software product (col. 6, lines 16-32); means for employing the information to authenticate the end-user (col. 6, lines 16-32); and means for employing a Licensing Authority to digitally sign the license when the end-user is

authentic (col. 6, lines 16-32; col. 5, lines 5-10), and wherein the license enables access to the software product. Since the license is generated by a trusted authority, and the license is signed and verified using a public key encryption algorithm, it is substantially similar in nature to a Public-Key Certificate in an Internet Public Key Infrastructure.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl as applied to claims 8 and 15 above, and further in view of "Wireless Application Protocol Public Key Infrastructure Definition".

Regarding claims 10-11 and 21, Puhl does not disclose that the license format is substantially similar to a X.509 format. The "Wireless Application Protocol Public Key Infrastructure Definition" reference discloses using X.509v3 format with Wireless Application Protocol Public Key Infrastructure (WAP PKI). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl method to use X.509v3 format, as taught in the "Wireless Application Protocol Public Key Infrastructure Definition" reference, in order to leverage the existing Internet PKIs. In addition, any new format that requires major change to the installed base of

certificate-processing products and CA infrastructure is unlikely to be easily adopted in a short timeframe (Section 1, page 5, last two paragraphs). Accordingly, the X.509v3 format includes an extension field comprising a URL.

Regarding claim 12, Puhl further discloses that the license comprises a digital signature associated with the Licensing Authority, wherein the digital signature is created using the RSA algorithm (col. 5, lines 5-11; col. 2, line 11).

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl. Puhl does not disclose expressly that the end user receives a rejection notice if it is determined that the end user is unauthentic. However, Examiner takes Official Notice that the end user receiving a rejection notice if it is determined that the end user is unauthentic is well known in the art. It would have been obvious at the time of the invention was made to modify the Puhl method to include the step of receiving a rejection notice if it is determined that the end user is unauthentic since Examiner takes Official Notice that the end user receiving a rejection notice if it is determined that the end user is unauthentic is well known in the art. Such a rejection notice lets the end user know the status of a request.

7. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl as applied to claim 15 above, and further in view of Tardo et al (6,557,105).

Regarding claims 16-17, Puhl discloses a software server receiving a request for the software product (fig. 3, step 226). Puhl does not disclose that the software server

receives the license associated with the software product, determines if the license is valid, and provides access to the software product if the license is valid. Tardo discloses a software server that receives a license associated with a software product, determines if the license is valid by examining a signature associated with a Licensing Authority, and provides access to the software product if the license is valid (fig. 1, element 104; col. 4, lines 5-13; col. 7, line 40 – col. 8, line 16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Puhl system such that the software server receives the license associated with the software product, determines if the license is valid by examining a signature associated with the Licensing Authority, and provides access to the software product if the license is valid, as taught by Tardo, in order to verify that the license is valid before actually enabling the software product (col. 8, lines 13-16).

Regarding claim 18, Puhl discloses a license revocation list from a Licensing Repository (col. 7, lines 3-7). Although Puhl does not disclose that the server utilize a license revocation list to determine if the license is valid, the feature is obvious by the combination of Puhl and Tardo discussed above.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mirsa et al, (6,189,146) discloses a system and method for software licensing.

Pettitt, (5,864,620), discloses a method for controlling distribution of software in a multitiered distribution chain.

Reddy et al, (6,824,051) discloses a protected content distribution system.

Hurst et al, (US 2003/0007646 A1), discloses a method for consumption of content.

RFC 2459 – Internet X.509 Public Key Infrastructure Certificate and CRL Profile.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2132

MD

Minh Dinh  
Examiner  
Art Unit 2132

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1/14/05

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